

REMARKS

Claims 1, 72, 134, 146 and 160 have been amended to clarify that certain steps of the methods set forth therein are implemented by computer. Claims 28-35, 62-64, 104-112, 131-133 and 175-177 have been amended to place them in independent form, including all of the limitations of the base claim and any intervening claims. The remaining claims remain unchanged from their original or previously presented version. Claim 140 has been reclassified as "previously presented" in accordance with the Examiner's remarks.

Claims 1-47, 72-116, 134-139, 146-152 and 160-177 Satisfy 35 U.S.C. § 101

The Examiner rejected claims 1-47, 72-116, 134-139, 146-152 and 160-177 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The Examiner contends that these claims are directed to non-statutory subject matter because it is not clear whether the heart of the invention utilizes technology. While Applicant respectfully disagrees with the Examiner's contention, Applicant has amended these claims in accordance with the Examiner's remarks to indicate that at least certain steps of the methods are performed by a computer to expedite issuance of a patent. Therefore, Applicant respectfully submits that claims 1-47, 72-116, 134-139, 146-152 and 160-177 satisfy 35 U.S.C. § 101 and reconsideration and withdrawal of the rejection of these claims is therefore respectfully requested.

Claims 1-27, 36-61, 65-1103, 113-130 AND 134-174 Are Patentable Over *PROXYEDGE 2000* and Harnett

The Examiner rejected claims 1-27, 36-61, 65-1103, 113-130 and 134-174 under 35 U.S.C. § 103(a) as being unpatentable over *ProxyEdge 2000* in view of U.S. Patent No. 6,112,188 to Harnett [hereinafter "Harnett"]. Essentially, the Examiner contends that *ProxyEdge 2000* discloses all of the elements of the claims at issue, except for teaching that the votes are performing automatically based on user-set preferences. The Examiner then contends that Harnett discloses this missing teaching. Applicant respectfully disagrees with the Examiner's characterization of these references vis-à-vis the claims at issue.

Claims 1 And 48 and Those That Depend Therefrom

With regard to independent claims 1 and 48 and the sets of claims that depend therefrom, each of these claims includes *inter alia* "receiving by a computer preferences regarding how to vote a user's shares in a corporation in a corporate voting, said preferences including an identification of one or more organizations whose voting recommendations are to be followed when voting the user's shares . . . and automatically voting the user's shares in accordance with the received preferences." The Examiner notes that *ProxyEdge 2000* fails to disclose that the votes are performed automatically based on user-set preferences. Applicant agrees with this contention.

Yet Harnett also fails to disclose this missing teaching. The Examiner provides several citations to Harnett, however, none of these citations provides this missing teaching, *i.e.*, that votes are automatically performed in accordance with user established preferences that include third party recommendations. The first citation to Harnett at column 9, lines 1-12 merely discusses delegation of voting authority. Delegation of voting authority in one's shares is not a new concept. For example, shareholder voting agreements have existed for some time. However, using a third party's recommendations as input to a voting process is new, novel and non-obvious. In the present invention, voting authority is not delegated to third party organizations, but rather the recommendations of third party organizations are used to determine how to automatically vote a shareholder's shares. According to the present invention, in all cases voting authority is retained by the shareholder.

The second citation to Harnett at column 16, lines 36-50 fails to discuss voting based on user-set preferences. This citation merely describes how authority needs to be delegated to a third party to oversee a prioritization process, and as such fails to relate to voting based on user set preferences.

Finally, the third citation to Harnett at column 42, lines 25-30 describes how an individual is selected to be on a mailing list to which a vote is sent, in which case some individuals may be selected in part based on delegation of voting authority. This selection process is irrelevant to voting based on user-set preferences.

Although the Examiner contends that Harnett teaches automated voting based on user-set preference, no citation to Harnett is provided by the Examiner discussing voting in accordance with user-set preferences.

Furthermore, the concept of delegation of voting authority teaches away from the concept of voting one's shares because the concept of delegation of voting authority teaches that one should delegate complete control over how one's shares are voted rather than continuing to vote one's shares. Retaining control is diametrically opposite to delegation of authority, hence delegation teaches away from retaining control. Thus, any reference that teaches delegation of voting authority cannot be used to contend that voting one's shares based on user set preferences regarding recommendations of third party organizations would have been obvious.

Moreover, as "[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. The requisite motivation must come from the prior art and *not Applicants' specification*." In re Dow Chem. Co., 5 USPQ2d 1529, 1531-32 (Fed. Cir. 1988). When an invention is directed to a combination of elements, both the Federal Circuit and the Board have consistently reversed rejections found on references merely showing that the claimed elements or subcombinations of the claimed elements were known. Rather, "either the references must expressly or impliedly suggest the claimed combination or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985).

In short, Applicant respectfully submits that the Examiner has failed to make a *prima facie* case for obviousness because the combination of these references (*i.e.*, *ProxyEdge 2000* and Harnett), even assuming *arguendo* they can be combined, does not disclose or suggest all elements of Applicant's rejected claims. As such, the claims at issue are neither anticipated by nor made obvious by these references (*i.e.*, *ProxyEdge 2000* and Harnett), either taken alone or in any combination.

Claim 65 And Those That Depend Therefrom

With regard to independent claim 65 and the set of claims that depend therefrom, each of these claims includes *inter alia* “an affinity group interface via which one or more affinity groups can enter voting recommendations on specific corporate actions of one or more corporations.” Neither *ProxyEdge 2000* nor Harnett discloses an affinity group interface via which an affinity group can enter voting recommendations on specific corporate actions of one or more corporations. Thus, Applicant respectfully submits that the Examiner has failed to make a *prima facie* case for obviousness because the combination of these references (*i.e.*, *ProxyEdge 2000* and Harnett), even assuming *arguendo* they can be combined, does not disclose or suggest all elements of Applicant’s rejected claims. As such, the claims at issue are neither anticipated by nor made obvious by these references (*i.e.*, *ProxyEdge 2000* and Harnett), either taken alone or in any combination.

Claims 72 and 117 And Those That Depend Therefrom

With regard to independent claims 72 and 117 and the sets of claims that depend therefrom, each of these claims includes *inter alia* “searching by a computer for a match between a plurality of preferences received from the shareholder as to how to vote shares and a plurality of corporate actions, said preferences including an identification of one or more organizations whose voting recommendations are to be followed when voting the user’s shares; and if a match results, automatically voting in at least one of the plurality of corporate actions in accordance with at least one corresponding preference.” None of the references cited by the Examiner provides for searching for a match between received shareholder preferences and corporate actions. Thus, Applicant respectfully submits that the Examiner has failed to make a *prima facie* case for obviousness because the combination of these references (*i.e.*, *ProxyEdge 2000* and Harnett), even assuming *arguendo* they can be combined, does not disclose or suggest all elements of Applicant’s rejected claims. As such, the claims at issue are neither anticipated by nor made obvious by these references (*i.e.*, *ProxyEdge 2000* and Harnett), either taken alone or in any combination.

Claims 134 and 140 And Those That Depend Therefrom

With regard to independent claims 134 and 140 and the sets of claims that depend therefrom, each of these claims includes *inter alia* “developing recommendations regarding a corporate voting; and communicating by a computer the recommendations to a service that automatically votes a user’s shares in the corporation based on user preferences regarding the recommendations.” None of the references cited by the Examiner provide for automatically voting shares based on voting recommendations of a third party. In these claims, the user employs a service to vote the shares, but third party recommendations are used to determine how to vote. This shows that the present invention is different than a mere delegation situation, in which a third party votes the shares. In this case, a third party still votes the shares, but using recommendations based on other organizations, as set forth by the user.

Thus, Applicant respectfully submits that the Examiner has failed to make a *prima facie* case for obviousness because the combination of these references (*i.e.*, *ProxyEdge 2000* and Harnett), even assuming *arguendo* they can be combined, does not disclose or suggest all elements of Applicant’s rejected claims. As such, the claims at issue are neither anticipated by nor made obvious by these references (*i.e.*, *ProxyEdge 2000* and Harnett), either taken alone or in any combination.

Claims 146 and 153 And Those That Depend Therefrom

With regard to independent claims 146 and 153 and the sets of claims that depend therefrom, each of these claims includes *inter alia* “communicating by a computer a corporate voting form for a user holding shares in a corporation; and receiving with a computer the user’s vote from a service that votes the user’s shares in accordance with preferences of the user regarding voting recommendations provided by one or more organizations.” As with the above claims, none of the references cited by the Examiner provide for automatically voting shares based on voting recommendations of a third party. Thus, Applicant respectfully submits that the Examiner has failed to make a *prima facie* case for obviousness because the combination of these references (*i.e.*, *ProxyEdge 2000* and Harnett), even assuming *arguendo* they can be combined, does not disclose or suggest all elements of Applicant’s rejected claims. As such, the

claims at issue are neither anticipated by nor made obvious by these references (*i.e.*, *ProxyEdge 2000* and Harnett), either taken alone or in any combination.

Claims 160 And Those That Depend Therefrom

With regard to independent claim 160 and the set of claims that depend therefrom, each of these claims includes *inter alia* “receiving by a computer preferences regarding how to vote a user’s shares in a corporation in a corporate voting, said preferences including an identification of one or more organizations whose voting recommendations are to be followed when voting the user’s shares; and automatically submitting the vote in accordance with the received preferences.” As with the above claims, none of the references cited by the Examiner provide for automatically voting shares based on voting recommendations of a third party. Thus, Applicant respectfully submits that the Examiner has failed to make a *prima facie* case for obviousness because the combination of these references (*i.e.*, *ProxyEdge 2000* and Harnett), even assuming *arguendo* they can be combined, does not disclose or suggest all elements of Applicant’s rejected claims. As such, the claims at issue are neither anticipated by nor made obvious by these references (*i.e.*, *ProxyEdge 2000* and Harnett), either taken alone or in any combination.

Allowability of Claims 28-35, 62-64, 104-112, 131-133 AND 175-177

Applicant gratefully acknowledges the Examiner’s finding that claims 28-35, 62-64, 104-112, 131-133 and 175-177 would be allowable if placed in independent form, including all of the limitations of the base claim and any intervening claims. Applicant has so amended these claims. Thus, claims 28-35, 62-64, 104-112, 131-133 and 175-177 should now be allowable.

Requirement for Information Under 37 C.F.R. § 1.105

The Examiner has requested information relating to products and services embodying the disclosed subject matter of U.S. Patent No. 6,601,044 B1, U.S. Patent No. 6,338,047 B1 and WO 99/46658 A2. Applicant is not aware of any products or services that implement the inventions set forth in U.S. Patent No. 6,338,047. Applicant is aware of a service that implements the inventions set forth in U.S. Patent No. 6,601,044 which can be found at <http://www.foliofn.com>. (Applicant, however, has not determined whether other trading systems that appeared in the marketplace after Applicant conceived of the inventions set forth in these patents embody any of

the aspects of the inventions claimed therein.) With regard to other products and services found in the prior art that relate to these patents, concomitant with his duty of disclosure during the prosecution of these patents under 37 C.F.R. § 1.56, Applicant has submitted extensive prior art that relates to products and or services having properties similar to the inventions set forth in the above-mentioned patents, which extensive prior art can be found on the face of the patents themselves. For the Examiner's convenience, Applicant submits this extensive set of prior art for consideration herein under an Information Disclosure Statement. Any other information is either unknown and/or not readily available to the Applicant or the assignee.

CONCLUSION

It is respectfully submitted that, in view of the foregoing amendments and remarks, the application is in clear condition for allowance. Issuance of a Notice of Allowance is earnestly solicited.

The Office is authorized to charge the three-month small entity extension of time fee of \$475.00 to Deposit Account No. 11-0600. The Office is hereby authorized to charge any additional fees required under 37 C.F.R. § 1.16 or § 1.17 or credit any overpayments to Deposit Account No. 11-0600.

The Examiner is invited to contact the undersigned at 202-220-4200 to discuss any matter regarding this application.

Respectfully submitted,
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